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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,092	02/21/2002	Barton A. Pasternak	35783-152950	2819
23973	7590	01/25/2005	EXAMINER	
DRINKER BIDDLE & REATH ONE LOGAN SQUARE 18TH AND CHERRY STREETS PHILADELPHIA, PA 19103-6996			NEGRON, ISMAEL	
			ART UNIT	PAPER NUMBER
			2875	

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

10/081,092

Applicant(s)

PASTERNAK ET AL.

Examiner

Ismael Negron

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-3 and 5-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed on November 29, 2004 has been entered. No claim has been amended or added. Claims 4 and 14 have been cancelled. Claims 1-3 and 5-13 are still pending in this application, with claims 1, 7, 8 and 13 being independent.
2. Applicant's request for reconsideration of the finality of the rejection of the last Office Action (Paper No. 20040602) is persuasive and, therefore, the finality of that action is withdrawn.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the *rotatable upper portion being adapted to rotate at least 360 degrees about an axis perpendicular to the lower portion* (as recited in claims 5 and 12) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement

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sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

5. Claim 6 is objected to because of the following informalities: it recites the limitation "*a light bulb*" as being part of the previously claimed adjustable device without specifying the structural relationship between the adjustable device and the newly claimed element. The Examiner suggest amending Claim 6 to read:

- A device as in claim 1, further comprising a light bulb
received in the rotatable upper portion.

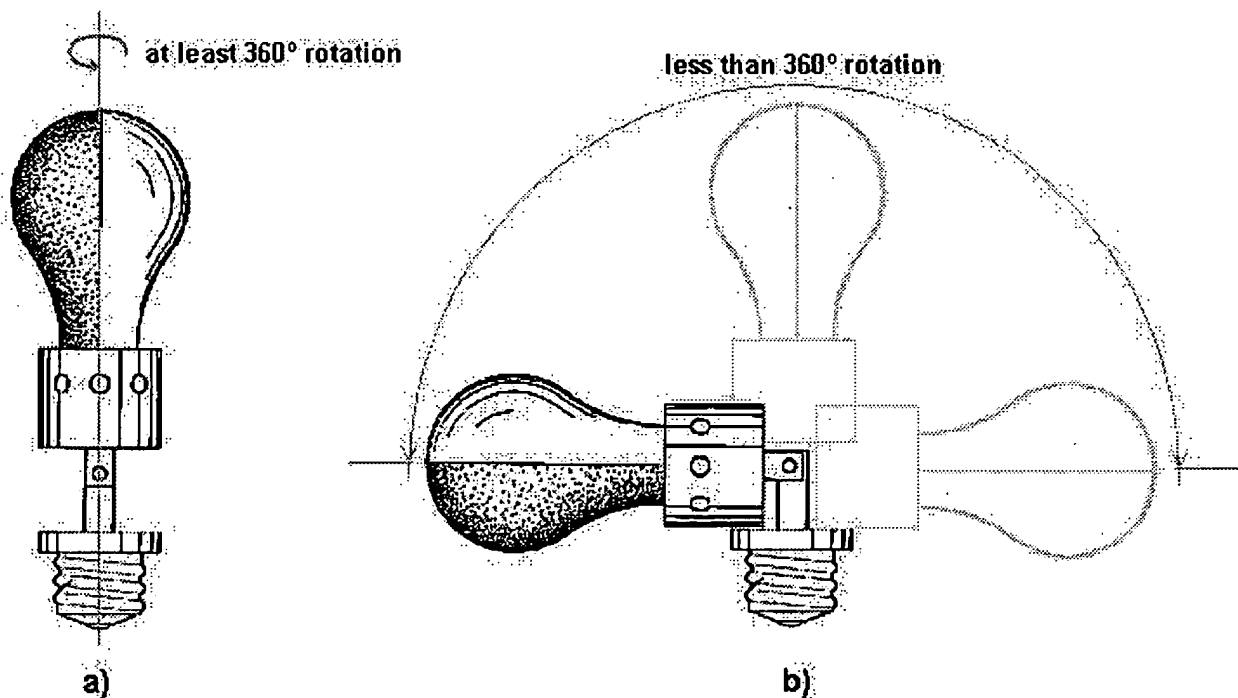
The cited objection do not amount to indefinitiveness under 35 U.S.C. 112, second paragraph, since the intended relationship between the light bulb of Claim 6 and the adjustable device of Claim 1 is readily apparent. However, appropriate correction is required to place the claims in proper form for allowance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 5 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification as filed discloses a socket adapter including a rotatable upper portion capable of rotating at least 360° about an axis parallel (emphasis added) to the lower portion, and less than 360° about any axis perpendicular to such lower



a) Figure 5 of the instant application shows rotation of at least 360° of the rotatable upper portion about an axis parallel to the lower portion, and b) Figure 6 shows such rotatable upper portion merely capable of less than 360° rotation about an axis perpendicular to the lower portion.

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portion. However, Claims 5 and 12 recites the rotatable upper portion as being adapted to rotate at least 360° about an axis perpendicular to the lower portion. The instant invention, as disclosed, is incapable of such at least 360° about an axis perpendicular to the lower portion as evidenced by figures 5 and 6.

7. The applicant is advised that for Prior Art rejection purposes the Examiner assumed the rotatable upper portion as being adapted to rotate at least 360° about an axis **parallel** to the lower portion. The applicant is further advised to review the correctness of the Examiner's assumptions.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 2, 5, 6 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by WOHL (U.S. Pat. 2,190,439).

WOHL discloses an adjustable illumination device having:

- **a directionally adjustable socket adapter (as recited in claims 1 and 13), as seen in Figure 1;**
- **a rotatable upper portion (as recited in claims 1 and 13), Figure 1, reference number 20;**

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- **the upper portion being for receiving a light bulb (as recited in claims 1 and 13), as seen in Figure 1;**
- **a lower portion (as recited in claims 1 and 13), Figure 1, reference number 10;**
- **the lower portion being adapted to engage a socket (as recited in Claim 1), column 1, lines 1-5;**
- **the rotatable upper portion being hingedly attached to the lower portion (as recited in claims 1 and 13), as evidenced by Figure 2;**
- **the upper portion also being rotatably attached to the lower portion (as recited in claims 1 and 13), column 2, lines 5-13;**
- **the directionally adjustable socket adapter being able to be positioned in a plurality of alternative directional arrangements (as recited in Claim 1), column 1, lines 6-10;**
- **the rotatable upper portion being adapted to rotate at least 360° about an axis perpendicular to the rotatable upper portion (as recited in Claim 1), column 1, lines 6-10;**
- **the rotatable upper portion having an outer housing (as recited in Claim 2), Figure 1, reference number 20;**
- **the rotatable upper portion having an inner socket (as recited in Claim 2), inherent;**

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- **the directionally adjustable socket adapter being adapted so that the socket adapter can be further adjusted by angularly positioning the rotatable upper portion in relation to the lower portion as desired (as recited in Claim 5), column 1, lines 6-10;**
- **the directionally adjustable socket adapter being adapted so that the socket adapter can be further adjusted by rotating the angularly positioned rotatable upper portion to a desired point within an at least 360° range of rotation about an axis parallel to the lower portion (as recited in Claim 5), column 1, lines 34-54;**
- **a light bulb (as recited in Claim 6), Figure 1, reference number 21;**
- **the lower portion being adapted so that the directionally adjustable socket adapter may be rotated at least 360° about at least one axis of rotation (as recited in Claim 13), column 1, lines 34-54;**
- **the lower portion being also adapted so that the directionally adjustable socket adapter may be angularly positioned in a plurality of angular positions about an axis different from the at least one axis of rotation (as recited in Claim 13), column 1, lines 6-10; and**

- **the lower portion being adapted for positioning the adjustable socket in a plurality of alternative directional arrangements (as recited in Claim 13), column 1, lines 6-10.**

The applicant is advised that it has been held by the courts that the recitation that an element is "adapted to" perform a function or serve in a given application is not a positive limitation, but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138. In this case, the patented structure of WOHL discloses all the claimed structural limitations, such structure was considered capable of performing all of the claimed functions.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over WOHL (U.S. Pat. 2,190,439) in view of ANGOTT (U.S. Pat. 4,684,822).

WOHL discloses an adjustable illumination device having:

- **a directionally adjustable socket adapter (as recited in Claim 1), as seen in Figure 1;**

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- **a rotatable upper portion (as recited in Claim 1), Figure 1, reference number 20;**
- **the upper portion being for receiving a light bulb (as recited in Claim 1), as seen in Figure 1;**
- **a lower portion (as recited in Claim 1), Figure 1, reference number 10;**
- **the lower portion being adapted to engage a socket (as recited in Claim 1), column 1, lines 1-5;**
- **the rotatable upper portion being hingedly attached to the lower portion (as recited in Claim 1), as evidenced by Figure 2;**
- **the upper portion also being rotatably attached to the lower portion (as recited in Claim 1), column 2, lines 5-13;**
- **the directionally adjustable socket adapter being able to be positioned in a plurality of alternative directional arrangements (as recited in Claim 1), column 1, lines 6-10;**
- **the rotatable upper portion being adapted to rotate at least 360° about an axis perpendicular to the rotatable upper portion (as recited in Claim 1), column 1, lines 6-10;**
- **the rotatable upper portion having an outer housing (as recited in Claim 2), Figure 1, reference number 20; and**
- **the rotatable upper portion having an inner socket (as recited in Claim 2), inherent.**

WOHL disclose all the limitations of the claims, except the outer including a plurality of sensors adapted to receive a remote signal for controlling the brightness of a light bulb in response to the signal (as recited in Claim 3).

ANGOTT disclose a lamp dimmer system for remotely controlling lamps.

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to include the lamp dimmer circuit of ANGOTT in the illumination device of WOHL and CHAN to be able to remotely control the operation of such illumination device, as per the teachings of ANGOTT (see column 1, lines 27-49).

In addition, the applicant is advised that it has been held by the courts that the recitation that an element is "adapted to" perform a function or serve in a given application is not a positive limitation, but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138. In this case, the patented structure of WOHL discloses all the claimed structural limitations, such structure was considered capable of performing all of the claimed functions.

10. Claims 8, 9, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over WOHL (U.S. Pat. 2,190,439).

WOHL discloses an adjustable illumination device having:

- **a light bulb (as recited in Claim 8)**, Figure 1, reference number 21;
- **a directionally adjustable socket adapter (as recited in Claim 8)**, as seen in Figure 1;

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- **a rotatable upper portion (as recited in Claim 8), Figure 1, reference number 20;**
- **the upper portion being for receiving a light bulb (as recited in Claim 8), as seen in Figure 1;**
- **a lower portion (as recited in Claim 8), Figure 1, reference number 10;**
- **the lower portion being adapted to engage a socket (as recited in Claim 8), column 1, lines 1-5;**
- **the rotatable upper portion being hingedly attached to the lower portion (as recited in Claim 8), as evidenced by Figure 2;**
- **the upper portion also being rotatably attached to the lower portion (as recited in Claim 8), column 2, lines 5-13;**
- **the directionally adjustable socket adapter being able to direct light emitted by the light bulb to a particular location as desired (as recited in Claim 8), column 1, lines 6-10;**
- **the rotatable upper portion having an outer housing (as recited in Claim 9), Figure 1, reference number 20;**
- **the rotatable upper portion having an inner socket (as recited in Claim 9), inherent;**
- **the rotatable upper portion being adapted to rotate at least 360° about an axis perpendicular to the rotatable upper portion (as recited in Claim 11), column 1, lines 6-10;**

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- **the directionally adjustable socket adapter being adapted so that the socket adapter can be further adjusted by angularly positioning the rotatable upper portion in relation to the lower portion as desired (as recited in Claim 12), column 1, lines 6-10;**
- **the directionally adjustable socket adapter being adapted so that the socket adapter can be further adjusted by rotating the angularly positioned rotatable upper portion to a desired point within an at least 360° range of rotation about an axis parallel to the lower portion (as recited in Claim 12), column 1, lines 34-54.**

WOHL disclose all the limitations of the claims, except the light bulb having a coating adapted to focus light emitted by the bulb in a particular direction.

The Examiner take Official Notice that the use and advantages of coated light bulbs is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to include such light bulb in the device of WOHL to increase the efficiency of the illumination device by concentrating and directing towards a desired direction of illumination light rays that would otherwise be directed in other directions.

In addition, the applicant is advised that it has been held by the courts that the recitation that an element is "adapted to" perform a function or serve in a given application is not a positive limitation, but only requires the ability to so perform. *In re*

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Hutchinson, 69 USPQ 138. In this case, the patented structure of WOHL discloses all the claimed structural limitations, such structure was considered capable of performing all of the claimed functions.

11. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over WOHL (U.S. Pat. 2,190,439) in view of ANGOTT (U.S. Pat. 4,684,822).

WOHL discloses an adjustable illumination device having:

- **a light bulb (as recited in Claim 8), Figure 1, reference number 21;**
- **a directionally adjustable socket adapter (as recited in Claim 8), as seen in Figure 1;**
- **a rotatable upper portion (as recited in Claim 8), Figure 1, reference number 20;**
- **the upper portion being for receiving a light bulb (as recited in Claim 8), as seen in Figure 1;**
- **a lower portion (as recited in Claim 8), Figure 1, reference number 10;**
- **the lower portion being adapted to engage a socket (as recited in Claim 8), column 1, lines 1-5;**
- **the rotatable upper portion being hingedly attached to the lower portion (as recited in Claim 8), as evidenced by Figure 2;**

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- **the upper portion also being rotatably attached to the lower portion (as recited in Claim 8), column 2, lines 5-13;**
- **the directionally adjustable socket adapter being able to direct light emitted by the light bulb to a particular location as desired (as recited in Claim 8), column 1, lines 6-10;**
- **the rotatable upper portion having an outer housing (as recited in Claim 9), Figure 1, reference number 20; and**
- **the rotatable upper portion having an inner socket (as recited in Claim 9), inherent.**

WOHL disclose all the limitations of the claims, except the outer including a plurality of sensors adapted to receive a remote signal for controlling the brightness of a light bulb in response to the signal (as recited in Claim 3).

ANGOTT disclose a lamp dimmer system for remotely controlling lamps.

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to include the lamp dimmer circuit of ANGOTT in the illumination device of WOHL and CHAN to be able to remotely control the operation of such illumination device, as per the teachings of ANGOTT (see column 1, lines 27-49).

In addition, the applicant is advised that it has been held by the courts that the recitation that an element is "adapted to" perform a function or serve in a given application is not a positive limitation, but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138. In this case, the patented structure of WOHL discloses all

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the claimed structural limitations, such structure was considered capable of performing all of the claimed functions.

Response to Arguments

12. Applicant's arguments with respect to claims 1-3 and 5-13 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negron whose telephone number is (571) 272-2376. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea, can be reached on (571) 272-2378. The facsimile machine number for the Art Group is (703) 872-9306.


14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications maybe obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://pair-direct.uspto.gov>. Should you

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have questions on access to Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197.


Inr

January 21, 2005


JOHN ANTHONY WARD
PRIMARY EXAMINER